

REMARKS

In accordance with the foregoing, claim 3 has been cancelled without prejudice or disclaimer.

Claims 1, 2, and 4-28 are pending and under consideration.

OBJECTION TO THE TITLE:

In the Office Action, at page 2, the title was objected to as not being descriptive. In view of the proposed amended title set forth above, the outstanding objection to the title should be resolved.

CHANGES TO THE ABSTRACT:

The abstract has been reviewed in response to this Office Action. Changes have been made to the specification only to place it in preferred and better U.S. form for issuance and to resolve the Examiner's objections raised in the Office Action. No new matter has been added as there is support for the changes in portions of the specification and drawings as originally filed.

REJECTION UNDER 35 U.S.C. § 112:

In the Office Action, at page 3, claims 1, 3, 11, and 21-28 are rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.

In response, claim 3 has been cancelled, without prejudice or disclaimer.

Referring to claims 1, 11, and 21-28, the Applicants traverse the rejection to these claims.

According to the Office Action, "an error cannot have a range; it is either an error or not." Applicant respectfully asserts that the recitations of the claims are being misconstrued. In particular, as recited in independent claim 1, for instance, "only when an error, between the image information and prestored image information, is within a predetermined range." It is not recited "only when an error...occurs" but when such error is within a predetermined range. A person of ordinary skilled in the art would appreciate that it is not the existence of the error that it is being claimed, but whether the error itself is within a predetermined range. Support for such

recitation may be found, for instance, on pages 15-16 of the Specification of the present application.

Furthermore, according to the Office Action, claim 8 raises an indefinite issue as the language in the claim raises doubt as being merely exemplary or being required. Applicant respectfully traverses the rejection to this claim. Claim 8 recites, "wherein the parameter includes character, image and/or audio information indicating a summary of the electronic mail." There is no exemplary language in the claim as defined by MPEP 2173.05(e) including "for example" and "such as." Alternative expressions such as "and/or" may be used in claim language, and should not be confused with exemplary language.

It is respectfully submitted that many patents have been issued including an "and/or" expression. Supervisory Patent Examiner Dharia who is the supervisor examiner in charge of the present application has issued some of these patents, for instance: 6,609,169; 6,591,326; 6,567,884; 6,292,863; 6,519,663; and 6,519,666. Further, Examiner Pollack also assisted in issuing a case, 6,751,658, which includes the "and/or" expression in the claims.

Accordingly, it is respectfully asserted that the parameter of the present application includes character, image and audio information, or includes character, image or audio information, recitations which are definite and permissible under current patent rules and procedures.

Further, claims 1, 11, and 21-28 are rejected "as it is unclear why a sender would set a block to filter his or her own messages." It is respectfully asserted that the claims do speak for themselves and that care must be taken avoid unwarranted interpretations, whether broad or narrow upon the claims. The language referred to in the Office Action is not recited in any of the claims of the present invention. Accordingly, it is unreasonable to request that the claims need to be further amended in view of recitations that are not recited in the claims.

In addition, improper and disrespectful language is used in the Office Action such as "it [the present application] is a lousy authentication device because an unauthorized user could use the computer later and simply attach the signature file saved on the hard drive." As much as the Applicant owes respect to the Examiner of record, the Examiner of record also owes a duty of respect to the Applicant and the Applicant's invention.

Also, the Office Action indicates, "there is no functional reason why said image would have to be part of the email, as it is the sending unit that performs the filtering operations."

According to current Patent rules and procedures, the definiteness of the language employed in the claims must be analyzed - not in a vacuum, but always in light of the teachings of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. It is asserted that the functional features recited in the independent claims are definite and should be interpreted in light of the Specification. The issues presented in the rejection to the claims is a why the invention done the way it is done rather than how it is being done. It is asserted that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims.

Accordingly, it is respectfully requested that the § 112, second paragraph rejections of the claims be withdrawn.

REJECTION UNDER 35 U.S.C. § 103:

On page 6 of the Office Action, claims 1, 2, 4, 10-12, 20, 23, 24, 26, and 27 are rejected under 35 U.S.C. § 103(a) as being obvious in view of U.S. Patent No. 6,332,193 to Glass et al. ("Glass") and U.S. Patent No. 6,018,761 to Uomini ("Uomini").

Glass generally describes a technique to securely transfer biometric information to an authentication apparatus. See abstract. According to the Office Action, FIG. 7, #17, shows electronic mail. Item #17 is described as "upon passing the biometric identification the client is provided access to the secured resource which is shown as box 17." See column 9, lines 54-56. However, nothing in the description corresponding to the referred item #17 indicates that the biometric identification is included in an electronic mail.

Furthermore, an authentication module in Glass contains or receives from another component in the Authentication Server System information that enables it to recognize the key from the secure camera as indicated by the key symbol input to box 15. See column 1, lines 40-47, and column 9, lines 50-55. If the outputs are the same the received image is valid and belongs with the particular transaction. The server can then take the image and perform the biometric identification as indicated by box 16. Upon passing the biometric identification the client is provided access to the secured resource, which is shown, as box 17. Furthermore, according to Glass, an encoded image cannot be used to identify a user more than once (or n times), and/or images remain valid only for some predetermined time period after which they will not be processed by the biometric algorithm since they have been deemed invalid by the

authentication system or server.

However, nothing in the cited reference teaches or suggests that the separate imaging system "transmits the electronic mail **only** when an error, between the image information and prestored image information, is within a predetermined range," emphasis added, as recited in independent claim 1. The cited reference limits its description as to indicating that images remain valid only for some predetermined time period, but does not describe that the electronic mail would be transmitted **only** when an "error between the image information and prestored image information, is within a predetermined range," as recited in independent claim 1.

According to the Office Action, "the above (Glass) teaches that the purpose is to secure access to various types of secured resources," however, Glass does not make any reference to such secured resources. Rather, Glass describes containing a sensor, preferably a camera, to collect the biometric data, which is transmitted over a network. **If** the data is authentic, the server then computes a biometric template using the data. The authentication module contains or receives information to recognize a key from the secure camera. However, contrary to the assertions made in the Office Action, nowhere in Glass is there any suggestion or motivation that the purpose is to secure access to various types of "secured resources." Accordingly, Applicant respectfully traverses the use of Official Notice to arrive to the recitations of the present claims.

"Rejection of patent application for obviousness under 35 U.S.C. §103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record." In re Lee 61 USPQ2d 1430 (CA FC 2002).

While "official notice" may be relied upon, as noted in MPEP §2144.03, these circumstances should be rare when an application is under final rejection or action under 37 CFR §1.113. Official Notice unsupported by documentary evidence should be only be taken by the Examiner where the facts asserted to be well known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known and only when such facts are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection.

The Applicant should be presented with the explicit basis on which the Examiner regards

the matter as subject to official notice sufficient to allow the applicant a proper opportunity to challenge that assertion.

Furthermore, the Office Action correctly recognized that Glass is silent as to teaching or suggesting, "transmitting electronic mail in which a symbol including image information, which enables a sender to be specified therefrom, is included within an electronic signature file of the electronic mail, said electronic signature file including an email address of the sender," as recited in independent claim 1. Accordingly the Office Action relies on Uomini.

Uomini generally describes a method of acquiring sender information of an electronic mail from a database or the like which stores the sender information separately from the message. However, similarly to Glass, Uomini is silent as to teaching or suggesting, "wherein said transmitter transmits the electronic mail only when an error, between the image information and prestored image information, is within a predetermined range," as recited in independent claim 1. Uomini provides that it is useful to find context information in legacy messages and messages where the sender has taken no action to supply context information. If the sender does not provide a key field, the "From:" and "Organization:" header fields can be used.

Uomini and Glass fail to broach the concept of transmitting "the electronic mail **only** when an error, between the image information and prestored image information, is within a predetermined range," emphasis added, as recited in independent claim 1.

According to the Office Action, "one of ordinary skill in the art would have combined the two inventions in order to better develop a digital signature that would be harder to manipulate," and refers to Glass column 7, line 65, to column 8, line 13. However, the referred portion merely describes generating unique values that would function as keys for a digital signature algorithm rather than just generating unique blocks of data. Contrary to the assertions made in the Office Action, nothing in the referred portion of Glass teaches or suggests a need of providing an "electronic mail in which a symbol including image information, which enables a sender to be specified therefrom, is included within an electronic signature file of the electronic mail," as recited in independent claim 1. Glass does not even mention electronic mail and merely relates to a technique for transferring the biometric information to the authentication apparatus.

MPEP § 706.02(j) requires that, to establish a *prima facie* case of obviousness under § 103, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. ... The teaching or suggestion to make the claimed combination

and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure."

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The Examiner has not presented any evidence why Glass would have been combined with Uomini. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. Id. The Examiner's sole support for such a combination is that "in order to better develop a digital signature that would be harder to manipulate." (Office Action, p. 6). The Examiner cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in any of the references, and the Examiner has not presented any actual evidence in support of the same. Instead, the Examiner relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and must be withdrawn.

Therefore, the Applicant respectfully submits that the rejections under section 103(a) are insufficient because the examiner has not presented a *prima facie* case of obviousness. The Applicant respectfully requests that the examiner withdraw the rejections.

Because independent claims 11, 23, 24, 26, and 27 include similar claim recitations as

those recited in independent claim 1, although of different scope, and because the Office Action refers to similar portions of the cited references to reject independent claims 11, 23, 24, 26, and 27, the arguments presented above supporting the patentability of independent claim 1 are incorporated herein to support the patentability of independent claims 11, 23, 24, 26, and 27.

On page 9 of the Office Action, claims 5-9, 13-19, 21, 22, 25, and 28 are rejected under 35 U.S.C. § 103(a) as being obvious in view of U.S. Patent No. 6,332,193 to Glass et al. ("Glass"), U.S. Patent No. 6,018,761 to Uomini ("Uomini"), and U.S. Patent No. 5,999,967 to Sundsted ("Sundsted").

The arguments presented above are incorporated herein to support the patentability of claim 5-9/1 and 13-19/11 over Glass and Uomini.

Sundsted generally provides allowing a receiver of electronic mail to make a decision to accept, reject, prioritize, or expedite delivery of a piece of electronic mail based on the value of an attached electronic stamp. A sender side type attaches the electronic stamp and a receiver side part removes the electronic stamp and filtering the electronic mail based on the value of the electronic stamp. Thus, the determination used in the apparatus described in Sundsted is based on the evaluation of the electronic stamp, not based on "only when an error, between the image information and prestored image information, is within a predetermined range," emphasis added, as recited in independent claim 1.

Thus, even assuming, *arguendo*, that Glass, Uomini, and Sundsted were combined; a combination thereof would fail to teach or suggest all the recitations of independent claim 1. In particular, the combination of the cited references would be silent as to teaching or suggesting, "wherein said transmitter transmits the electronic mail only when an error, between the image information and prestored image information, is within a predetermined range," as recited in independent claim 1.

In addition, the motivation to combine Glass, Uomini, and Sundsted is provided in the Office Action as "one of ordinary skill in the art would have added a Sundsted system as a method of assisting the receiver in determining the mail's importance." However, the Office Action fails to provide evidentiary support in Glass and Uomini as needing the system of Sundsted where the receiver can trust the sender's evaluation of the importance of the electronic mail. Glass does not even mention electronic mail and merely relates to a technique for transferring the biometric information to the authentication apparatus. Uomini, in turn, merely provides that it is useful to find context information in legacy messages and messages where the

sender has taken no action to supply context information. However, neither Glass nor Uomini suggest a need to assisting the receiver in determining the mail's importance of Sundsted.

The authorities previously set forth supporting improper motivation provided in the Office Action are incorporated herein.

Because independent claims 11, 21, 22, 25, and 28 include similar claim recitations as those recited in independent claim 1, although of different scope, and because the Office Action refers to similar portions of the cited references to reject independent claims 11, 21, 22, 25, and 28, the arguments presented above supporting the patentability of independent claim 1 are incorporated herein to support the patentability of independent claims 11, 21, 22, 25, and 28.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. There being no further outstanding objections or rejections, the application is submitted as being in condition for allowance, which action is earnestly solicited.


If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner's contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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